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JUN 15 2009

OFFICE OF PETITIONS

In re Application of	:	
Szabo	:	
Application No. 10/728,743	:	DECISION
Filed: 4 December, 2003	:	
Attorney Docket No. 93988	:	

This is a decision on the petition, filed on 27 April, 2009, for revival of an application abandoned due to unintentional delay.

The petition as considered under 37 C.F.R. §1.137(b) is **GRANTED**.

As to Allegations of
Unintentional Delay

The requirements of a grantable petition pursuant to 37 C.F.R. §1.137(b) are the petition and fee therefor, a reply, a proper statement of unintentional delay under the regulation, and, where applicable, a terminal disclaimer and fee. (However, it does not appear that a terminal disclaimer and fee are due here.)

Petitioners attentions always are directed to the Commentary at MPEP §711.03(c) for guidance as to satisfying the requirements for relief under 37 C.F.R. §1.137.

BACKGROUND

The record reflects as follows:

Former Counsel failed to reply timely and properly to the non-final Office action mailed on 16 November, 2007, with reply due absent extension of time on or before 16 February, 2008.

Prior Counsel filed a reply in the form of an amendment on 15 February, 2008.

On 16 June, 2008, the Office mailed a Notice of Non-Compliant Amendment with a one-month period for reply and the indication that an extension of time could be obtained—the limitation upon extension being the statutory constraint (35 U.S.C. §133) and compliance with the regulations at 37 C.F.R. §1.134(c). Thus, extension of time could not take one out more than six (6) months from the Office action in question.

On 16 July, 2008, former Counsel filed a reply to the 16 June, 2008, Notice of Non-Compliant Amendment, which reply prior Counsel supplemented on 28 August, 2008.

On 8 October, 2008, the Office again mailed a Notice of Non-Compliant Amendment with a one-month period for reply and the indication that an extension of time could be obtained—again with the statutory limitation (35 U.S.C. §133) and compliance with the regulations at 37 C.F.R. §1.134(c) such that an extension of time could not take one out more than six (6) months from the Office action in question

The application went abandoned by operation of law after midnight 8 November, 2008.

The Office mailed the Notice of Abandonment on 28 January, 2009.

On 10 February, 2009, Petitioner filed a petition (with fee) pursuant to 37 C.F.R. §1.137(a) averring unavoidable delay but also suggested non-receipt (properly considered under 37 C.F.R. §1.181), and a reply in the form of oath/declaration, fees, surcharge. Petitioner further seemed to suggest—but most certainly could not have suggested—that the reply period for the 16 November, 2007, non-final Office action could be extended “up to and including April 8, 2009.” The problems that confronted Petitioner here included: the Notice of Non-Compliant Amendment provided a one- (1-) month period in which to make a bona fide effort to reply, and extensions of time could be available—with the statutory limitation (35 U.S.C. §133) and compliance with the regulations at 37 C.F.R. §1.134(c), which did not permit an extension of time of more than six (6) months from the Office action in question; the inability to submit a compliant amendment is not a basis for averment of unavoidable delay (*see*: the Commentary at MPEP §711.03(c)(II)); the inability to submit a compliant amendment is not a basis for averment to support a petition pursuant to 37 C.F.R. §1.181 (*see*: the Commentary at MPEP §711.03(c)(I)); Petitioner acknowledged that he was not Counsel of Record and was not in control of the application at the time the application went abandoned—and Petitioners always are reminded as to their duty of to inquire in support of their duty of candor to the Office in advance of filing papers in an application;¹ and in this connection Petitioner is reminded to have prior Counsel sign any petition to revive pursuant to 37 C.F.R. §1.137(b) (averring unintentional delay) and to make such inquiry as necessary to ensure to his satisfaction the accuracy of such averments when made. The petition(s) was/were dismissed on 12 March, 2009

¹ See supplement of 17 June, 1999. The Patent and Trademark Office is relying on Applicant's duty of candor and good faith and accepting a statement made by Applicant. See *Changes to Patent Practice and Procedure*, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing statements to the Patent and Trademark Office).

On 27 April, 2009, Petitioner filed, *inter alia*, a petition pursuant to 37 C.F.R. §1.137(b), with fee, with a statement of unintentional delay and a reply was in the form of an amendment (Response to Notice of Non-Compliant Amendment).

The availability of applications and application papers online to applicants/practitioners who diligently associate their Customer Number with the respective application(s) now provides an applicant/practitioner on-demand information as to events/transactions in an application.

Out of an abundance of caution, Petitioners always are reminded that those registered to practice and all others who make representations before the Office **must** inquire into the underlying facts of representations made to the Office and support averments with the appropriate documentation—since all owe to the Office the continuing duty to disclose.²

STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).³ The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a Petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority.

Unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.⁴))

As to Allegations of Unintentional Delay

The requirements of a grantable petition pursuant to 37 C.F.R. §1.137(b) are the petition and fee therefor, a reply, a proper statement of unintentional delay under the regulation, and, where applicable, a terminal disclaimer and fee. (However, it does not appear that a terminal disclaimer and fee are due here.)

It appears that the requirements under 37 C.F.R. §1.137(b) have been satisfied.

² See supplement of 17 June, 1999. The Patent and Trademark Office is relying on petitioner's duty of candor and good faith and accepting a statement made by Petitioner. See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing statements to the Patent and Trademark Office).

³ 35 U.S.C. §133 provides:

35 U.S.C. §133 Time for prosecuting application.

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

⁴ Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.


CONCLUSION

Accordingly, the petition under 37 C.F.R. §1.137(b) is granted.

The instant application is released to the Technology Center/AU 2174 for further processing in due course.

Petitioner may find it beneficial to view Private PAIR within a fortnight of the instant decision to ensure that the revival has been acknowledged by the TC/AU in response to this decision. It is noted that all inquiries with regard to that change in status need be directed to the OTC/AU where that change of status must be effected—that does not occur in the Office of Petitions.

Telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3214—it is noted, however, that all practice before the Office is in writing (see: 37 C.F.R. §1.2⁵) and the proper authority for action on any matter in this regard are the statutes (35 U.S.C.), regulations (37 C.F.R.) and the commentary on policy (MPEP). Therefore, no telephone discussion may be controlling or considered authority for Petitioner's action(s).


/John J. Gillon, Jr./
John J. Gillon, Jr.
Senior Attorney
Office of Petitions

⁵ The regulations at 37 C.F.R. §1.2 provide:

§1.2 Business to be transacted in writing.

All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.